
To: Swanson Tool Company, Inc. (officeactions@norvellip.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77320288 - H - 9727-1039
Sent: 5/20/2009 9:38:57 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/320288

MARK: H



CORRESPONDENT ADDRESS:

JOSEPH T. KUCALA, JR.
NORVELL IP LLC
1776 ASH ST
NORTHFIELD, IL 60093-3001

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Swanson Tool Company, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

9727-1039

CORRESPONDENT E-MAIL ADDRESS:
officeactions@norvellip.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/20/2009

Applicant is requesting reconsideration of a final refusal issued/mailed 10/06/2008.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Dominant Feature of Mark - Literal Portion

The word portions are generally the dominant and most significant features of marks because consumers will call for the goods and/or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554, 556 (TTAB 1978). For this reason, greater weight is often given to the word portions of marks in determining whether there is a likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii).

Here, the marks are similar because the literal portions are identical, namely, H. Therefore consumers

will call for the goods in the marketplace by that portion, namely, **H**.

Therefore, the marks are confusingly similar.

Word Dominant over Design

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

Here, the marks are similar because the literal portions are identical, namely, **H**. Therefore consumers will call for the goods in the marketplace by that portion, namely, **H**.

Therefore, the marks are confusingly similar.

Comparing the Marks - Not a Side-by-Side Comparison

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Here, the marks are similar because the literal portions are identical, namely, **H**. Therefore consumers will call for the goods in the marketplace by that portion, namely, **H**.

Therefore, the marks are confusingly similar.

Third-Party Registrations – Past Examiners

Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Here, the marks are similar because the literal portions are identical, namely, **H**. Therefore consumers will call for the goods in the marketplace by that portion, namely, **H**. Furthermore, Applicant and Registrant's goods are identical and highly related, namely, squares, utility knives and hand tools. Therefore, the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to confusion as to origin.

Alleged "Weak" Mark

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Here, the marks are similar because the literal portions are identical, namely, H. Therefore consumers will call for the goods in the marketplace by that portion, namely, H. Furthermore, Applicant and Registrant's goods are identical and highly related, namely, squares, utility knives and hand tools. Therefore, the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to confusion as to origin.

Conclusion

Therefore, for all the reasons of record, registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3099993.

Accordingly, applicant's request for reconsideration is denied. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

If applicant has questions about its application or this Office action, please contact the assigned trademark examining attorney at the telephone number below.

/Paul A. Moreno/
United States Patent and Trademark Office
Trademark Attorney
Law Office 103
571-272-2651

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Swanson Tool Company, Inc. (officeactions@norvellip.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77320288 - H - 9727-1039
Sent: 5/20/2009 9:39:00 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 5/20/2009 FOR
APPLICATION SERIAL NO. 77320288

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77320288&doc_type=REC&mail_date=20090520 (or copy and paste this URL into the address field of your browser), or visit <http://tmportal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from **5/20/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**